

26-08-06

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Express Mail No. EL 989593749 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Graham, et al.

Serial No.: 10/659,529

Filed: September 9, 2003

For: FLUORESCENT ENZYME ASSAY
METHODS AND COMPOSITIONS

Docket No: 375461-007US (355357)

Confirmation No.: 4786

Group Art Unit: 1651

Examiner: Hanley, S.

TRANSMITTAL

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed are the following documents for filing in the above-referenced patent application:

- Fee Transmittal
- Amendment/Reply
- Petition for Extension of Time
- Supplemental Information Disclosure Statement
- Substitute form Form 1449A/PTO
- 30 IDS References
- International/Foreign Search Report
- Affidavit/Declaration
- Terminal Disclaimer
- Other (*itemize*)
- Notice of Appeal
- Request for Continued Examination
- Appeal Brief/Reply Brief
- Power of Attorney/Revocation
- Change of Attorney Docket Number
- Sequence Listing
- CRF Diskette
- CD Disc
- Return Receipt Postcard
- Exhibits (*itemize*)

1.

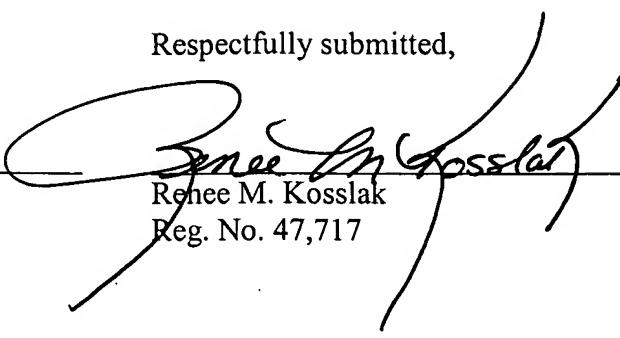
1.

Please direct any inquiries in connection with the above referenced application to the undersigned at telephone number (415) 262-4577.

Respectfully submitted,

Date: June 6, 2006

DECHERT LLP
Customer No. 37509
Telephone: 650.813.4800
Facsimile: 650.813.4848


Renee M. Kossak
Reg. No. 47,717

12656350.1.BUSINESS



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SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §§ 1.97 and 1.98, Applicant submits herewith patents, publications and/or other information (listed below and/or on the attached Substitute Form PTO 1449) that may be material to the examination of the captioned application, and in respect of which there may be a duty of disclosure as set forth in 37 CFR § 1.56, for consideration and to be made of record in the captioned application by the U.S. Patent and Trademark Office.

1. In accordance with 37 CFR 1.98, accompanying this Supplemental Information Disclosure Statement are:

1a. copies of: (i) each foreign patent listed on the attached Substitute Form PTO 1449; (ii) each publication listed on the attached Substitute Form PTO 1449, or that portion which caused it to be listed, *other than* U.S. patents and U.S. patent application publications; (iii) for each pending unpublished U.S. application, a copy of the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and (iv) other information, or

that portion which caused it to be listed herein or on the attached Substitute Form PTO-1449
(37 CFR § 1.98(a)(2)); and/or

1b. a concise explanation of relevancy, or an English language translation, of non-English language publications listed on the attached Substitute Form PTO-1449
(37 CFR § 1.98(a)(3)(i) & (ii)).

2. Copies of the documents listed on the attached Substitute Form PTO 1449 that are further identified by asterisks are not enclosed herewith, because the information was previously submitted to, or cited by, the U.S. Patent and Trademark Office in parent application Serial No. _____, of which the captioned application claims benefit under 35 U.S.C. § 120, and the Supplemental Information Disclosure Statement submitted in that parent application complied with paragraphs (a) through (c) of 37 CFR § 1.98 (37 CFR § 1.98(d)).

3. This Supplemental Information Disclosure Statement is filed under 37 CFR § 1.97(b):

3a. within three months of the filing date of a national application other than a continued prosecution application under 37 CFR § 1.53(d);

3b. within three months of the entry of the national stage as set forth in 37 CFR § 1.491 in an international application;

3c. before the mailing of a first Office Action on the merits; *or*

3d. before the mailing of a first Office Action after the filing of a Request for Continued Examination under 37 CFR § 1.114. Accordingly, no certification or fee is required.

4. This Supplemental Information Disclosure Statement is filed under CFR § 1.97(c) after the period specified by CFR § 1.97(b), but before the mailing date of any of a final Office Action under 37 CFR § 1.113, a notice of allowance under 37 CFR § 1.311, or an action that otherwise closes prosecution in the application, and is accompanied by one of:

4a. the statement specified in 37 CFR § 1.97(e); *or*

4b. the fee set forth in 37 CFR § 1.17(p).

5. This Supplemental Information Disclosure Statement is filed under 37 CFR § 1.97(d) after the period specified by CFR § 1.97(c), but on or before payment of the issue fee, and is accompanied by:

5a. the statement specified in 37 CFR § 1.97(e); *and*

5b. the fee set forth in 37 CFR § 1.17(p).

6. Certification Statement (*applicable if Item 4a or 5a is checked*)

6a. In accordance with 37 CFR § 1.97(e)(1), the undersigned hereby states that each item of information contained in this Supplemental Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Supplemental Information Disclosure Statement; *or*

6b. In accordance with 37 CFR § 1.97(e)(2), the undersigned hereby states that no item of information contained in this Supplemental Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making a reasonable inquiry, no item of information contained in this Supplemental Information Disclosure Statement was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of this Supplemental Information Disclosure Statement.

7. Fee Statement and/or Authorization (*applicable if Item 4b or 5b is checked*)

7a. The fee set forth in 37 CFR § 1.17(p) is:

enclosed; *or*

to be charged to Dechert LLP Deposit Account No. 50-2778 (**Order No.** - ()).

8. Additional materials (*if applicable*)

8a. a continuation application under 37 CFR § 1.53(b)(1) is filed concurrently herewith;

8b. a Request for Continued Examination under 37 CFR § 1.114 is filed concurrently herewith; *or*

8c. a Petition to Withdraw from issue under 37 CFR § 1.313(c)(2).

Further, in satisfaction of the duty of disclosure under 37 C.F.R. § 156, and as required by M.P.E.P. § 2001.06(b), Applicant notes that the present application is related to the following pending patent applications:

1. U.S.S.N. 11/261,173, filed October 27, 2005;
2. U.S.S.N 11/322,013, filed December 29, 2005; and
3. U.S.S.N 11/142,617, filed June 1, 2005;

As specified in 37 CFR § 1.97(g), the filing of this Supplemental Information Disclosure Statement shall not be construed as a representation that a search has been made.

The filing of this Supplemental Information Disclosure Statement shall not be construed as a representation that no other material information as defined in 37 CFR § 1.56(a) exists.

As specified in 37 CFR § 1.97(h), the filing of this Supplemental Information Disclosure Statement shall not be construed to be an admission that any information cited herein is, or is considered to be, material to patentability as defined in 37 CFR § 1.56(b).

Moreover, while the patents, publications and/or other information disclosed in this Supplemental Information Disclosure Statement may be “material” pursuant to 37 CFR § 1.56,

the Disclosure is not intended to constitute an admission that any patents, publications and/or other information included or referred to herein is "prior art" to the captioned application unless specifically designated as such.

It is respectfully submitted that this Supplemental Information Disclosure Statement is in compliance with 37 CFR § 1.98 and MPEP § 609. Accordingly, consideration of the foregoing and prompt return of a copy of the enclosed Substitute form PTO 1449 with the Examiner's initials in the left column in accordance with MPEP § 609 are respectfully requested.

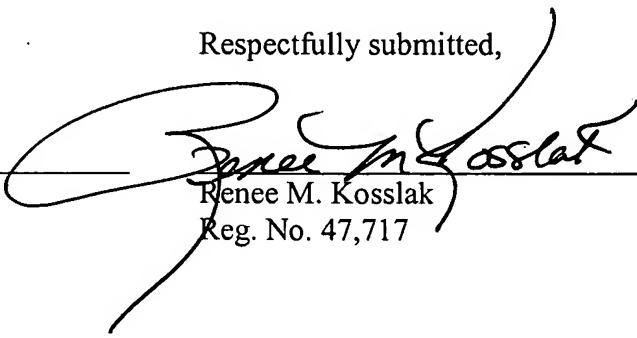
No fees are believed due in connection with this Supplemental Information Disclosure Statement. However, the Commissioner is authorized to charge any additional required fees, or credit any overpayment, to Dechert LLP Deposit Account No. 50-2778 (**Order No. 375461-007US (355357)**).

Please direct any inquiries in connection with the above referenced application to the undersigned at telephone number (415) 262-4577.

Date: June 6, 2006

DECHERT LLP
Customer No. 37509
Telephone: 650.813.4800
Facsimile: 650.813.4848

Respectfully submitted,


Renee M. Kossak
Reg. No. 47,717

12586884.1.BUSINESS



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|---|---|----|---|------------------------|-----------------------|
| Substitute for form 1449A/PTO (Modified) | | | | Complete if Known | |
| | | | | Application Number | 10/659,529 |
| | | | | Filing Date | September 9, 2003 |
| | | | | First Named Inventor | Graham, et al. |
| | | | | Art Unit | 1651 |
| | | | | Examiner Name | Hanley, S. |
| Sheet | 1 | of | 3 | Attorney Docket Number | 375461-007US (355357) |

| U.S. PATENT DOCUMENTS | | | | |
|-----------------------|----------|---|--------------------------------|---|
| Examiner Initials* | Cite No. | Document Number Number-Kind Code ² (if known) | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document |
| | A1 | US 5089392 | 02-18-1992 | Miller, et al. |
| | A2 | US 5210040 | 05-11-1993 | Jou, et al. |
| | A3 | US 5366895 | 11-22-1994 | Rutner, et al. |
| | A4 | US 5912137 | 06-15-1999 | Tsien et al. |
| | A5 | US 5925558 | 07-20-1999 | Tsien, et al. |
| | A6 | US 5958713 | 09-28-1999 | Thastrup, et al. |
| | A7 | US 6143716 | 11-07-2000 | Meers et al. |
| | A8 | US 6235535 | 05-22-2001 | Keinänen, et al. |
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| | A12 | US 2003/135869 | 07-17-2003 | Farber, Steven et al. |
| | A13 | US 2005/0239217 | 10-27-05 | Graham, et al. |
| | A14 | US 2005/0245726 | 11-03-2005 | Lee, et al. |
| | A15 | US 2005/0244891 | 11-03-2005 | Graham, et al. |
| | A16 | US 2005/0244907 | 11-03-2005 | Graham, et al. |
| | A17 | US 2006/0003383 | 01-05-2006 | Graham, Ronald J. |
| | A18 | US 2006/0035302 | 02-16-2006 | Lee, Linda G. |
| | A19 | | | |
| | A20 | | | |
| | A21 | | | |
| | A22 | | | |
| | A23 | | | |
| | A24 | | | |

FOREIGN PATENT DOCUMENTS

| | |
|--------------------|-----------------|
| Examiner Signature | Date Considered |
|--------------------|-----------------|

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English Language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the complete application form to the USPTO. Time will vary depending on the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and selection option 2

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|---|---|----|---|--------------------------|-------------------|
| Substitute for form 1449A/PTO (Modified) | | | | Complete if Known | |
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary) | | | | Application Number | 10/659,529 |
| | | | | Filing Date | September 9, 2003 |
| | | | | First Named Inventor | Graham, et al. |
| | | | | Art Unit | 1651 |
| | | | | Examiner Name | Hanley, S. |
| Sheet | 2 | of | 3 | Attorney Docket Number | |
| 375461-007US (355357) | | | | | |

| Examiner Initials* | Cite No. ² | Foreign Patent Document Country Code ³ Number ⁴ Kind Code ⁵ (if known) | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | # ⁶ |
|--------------------|-----------------------|--|--------------------------------|---|----------------|
| | B1 | WO 99/18856 | 04-22-1999 | Cytovia, Inc. | |
| | B2 | WO 99/29894 | 06-17-1999 | Pharmacia & Upjohn Company | |
| | B3 | WO 00/09539 | 02-24-2000 | University of New Mexico | |
| | B4 | WO 00/18949 | 04-06-2000 | University of Utah Research Foundation Utah State University | |
| | B5 | WO 00/50635 | 08-31-2000 | Fluorescence Limited | |
| | B6 | WO 00/66766 | 11-09-2000 | Aurora Biosciences Corp. | |
| | B7 | WO 01/07638 | 02-01-2001 | University of Utah Research Foundation | |
| | B8 | WO 01/43778 | 06-21-2001 | Gene Therapy Systems, Inc. | |
| | B9 | WO 02/079268 | 10-10-2002 | The Regents of the University of California | |
| | B10 | WO 05/054495 | 06-16-2005 | Applera Corporation | |
| | B11 | WO 05/054856 | 06-16-2005 | Applera Corporation | |
| | B12 | WO 05/071095 | 08-04-2005 | Applera Corporation | |
| | B13 | WO 05/059163 | 06-30-2005 | Applera Corporation | |
| | B14 | WO 06/002221 | 01-05-2006 | Applera Corporation | |
| | B15 | | | | |
| | B16 | | | | |
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| | | | | Art Unit | 1651 |
| | | | | Examiner Name | Hanley, S. |
| Sheet | 3 | of | 3 | Attorney Docket Number | |
| NON PATENT LITERATURE DOCUMENTS | | | | | |

| Examiner Initials* | Cite No.* | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | | | | † ⁶ |
|--------------------|-----------|---|--|--|--|----------------|
| | C1 | BYK, et al, 1998, J. Med. Chem, 41:224-235. | | | | |
| | C2 | CHEN, et al., 2002, J. Am. Chem. Soc., 2002, 124:3840-3841 | | | | |
| | C3 | FUJIMORI, et al., 1983, Cellular & Mo. Biol., 29(1):19-22 | | | | |
| | C4 | HENDRICKSON, 1994, Anal. Biochem., 219(1):1-8 | | | | |
| | C5 | HENDRICKSON, 1999, Anal. Biochem., 276:27-35 | | | | |
| | C6 | JEONG and NIKIFOROV, December 1999, BioTechniques, 27:1232-1238 | | | | |
| | C7 | LEE, et al., 2002, Abstract, IBC Conference, Sept. 9-10, Boston | | | | |
| | C8 | LEE, et. al., 2003, Intl. J. Pharmaceutics, 251:23-32 | | | | |
| | C9 | MATVEEVA, et al., 1996, Anal. Biochem., 234:13-18 | | | | |
| | C10 | PAP, et al., 1995, J. of Biol. Chem., 270(3):1254-1260 | | | | |
| | C11 | Promega Technical Bulletin No. 132 | | | | |
| | C12 | SHULTS and IMPERIALI, 2003, J. Am. Chem. Soc., 2003, 125:14248-14249 | | | | |
| | C13 | SUN, et al., 2003, Abstract, SBS Conference, p. 217 | | | | |
| | C14 | SUN, et al., 2005, Anal. Chem., 77:2043-2049 | | | | |
| | C15 | TAN, et al., 2002, J. Am. Chem. Soc., 2002, 124:11827-11832 | | | | |
| | C16 | YAMAJI, et al., 1997, J. Fermentation & Bioengineering, 83(6):596-598 | | | | |
| | C17 | YEH, et. al., March 29 th 2002, J. of Biol. Chem., 277(13):11527-11532 | | | | |
| | C18 | | | | | |
| | C19 | | | | | |
| | C20 | | | | | |
| | C21 | | | | | |
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